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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,466	07/09/2001	Stephen J. Lippard	MTV-033.01	5664
25181	7590	06/04/2004	EXAMINER	
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			CEPERLEY, MARY	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,466

Applicant(s)

LIPPARD ET AL.

Examiner

Mary (Molly) E. Ceperley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 12-19, 31-47 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20-30 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1) Applicants' complete supplemental response of March 11, 2004 which addresses in detail all of the rejections of record with citations to relevant sections of the specification is acknowledged.

2) Although specific claims are referenced in the rejections set forth below, these rejections are also applicable to all other claims in which the noted problems/language occur.

3) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4) Claims 1-11, 20-30 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) For claim 1, the written description of the specification does not support the new generic definition of the variable "V", namely "V" defined as "a chemical moiety comprising **(i)** at least three Lewis bases that are capable of forming a tridentate chelating agent, wherein at least one of said three Lewis bases is a ring heteroatom of a heterocyclic group, or **(ii)** a secondary nitrogen atom double bonded to a carbon atom of A to form an imine wherein said secondary nitrogen atom is capable of forming a bidentate chelating agent with the oxygen atom of OZ or Q".

The examiner has carefully reviewed the specification, in particular the sections cited by the applicants in the fourth paragraph of page 25 of the March 11, 2004 response, but can find no support for the newly recited subgenus. Although certain compounds described in the specification may be encompassed by the newly defined subgenus (e.g. Fig. 8 describing a

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compound wherein "V" contains an imine; Fig. 9, describing a particular "tridentate" compound) neither the description of these specific compounds nor the general description of "V" which appears at page 34, second paragraph through page 36, second paragraph constitutes a description adequate to support the subgenus newly defined in claim 1. See the following sections of the MPEP: 608.01(o); 608.04(a); 2163,IB. citing *In re Lukach* {442 F.2d 967, 169 USPQ 795 (CCPA 1971)} and *In re Smith* {458 F.2d 1389, 1395; 173 USPQ 679, 683 (CCPA 1972)}; 2163.05, II.

b) There is no support in the specification for the term "D" as defined in formula III of claim 1. Applicants' comments in the March 11, 2004 Remarks which appear in the paragraph bridging pages 25 and 26 and in the first full paragraph of page 26 have been considered but are not persuasive. The comments relate to the lactone and free acid forms of fluorescein but the newly presented $-\text{CH}_2\text{CH}_2-$ and $-\text{CH}=\text{CH}-$ definitions of D do not relate to the lactone/free acid forms of fluorescein and are not definitions presented in the specification.

c) No support can be found in the specification for the following variable definitions (see claim 1):

(i) "A" defined as " $-\text{CH}_2\text{C}(=\text{O})-$ ", " $-\text{CH}_2\text{C}(=\text{S})-$ ", " $-\text{C}(\text{H})=$ " and "with the hydrogen atoms optionally substituted". See the first paragraph of page 32 of the specification.

(ii) "K" and "E" each defined as "aliphatic", "aralkyl", "aryl", "amido", "sulfonate", "sulfate", "sulfamoyl", "sulfoxido" and "selenoalkyl".

(iii) The "phenyl" moiety of "Z2" defined as "phenyl moiety is optionally substituted with one or more E...other than carboxylic acid". See page 31 of the specification, section 5.3.

(iv) The last definition appearing under "Z2" in claim 1, i.e., "said carbonyls are optionally a carbonyl other than carboxylic acid".

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5) Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

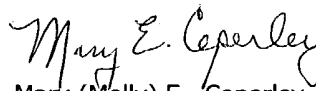
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6) An inquiry of a general nature which is **not related to the prosecution on the merits** should be directed to Technology Center 1600 telephone number (571) 272-1600. The general fax number for the USPTO is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823.

May 28, 2004


Mary (Molly) E. Ceperley
Primary Examiner
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